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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,487	02/02/2001	Gregg B. Morrison	145415.00001	5305
27781	7590	06/06/2005	EXAMINER	
POWELL, GOLDSTEIN, FRAZER & MURPHY LLP P.O. BOX 97233 WASHINGTON, DC 20090-7223			DADA, BEEMNET W	
		ART UNIT		PAPER NUMBER
		2135		

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/773,487	MORRISON, GREGG B.
	Examiner	Art Unit
	Beemnet W. Dada	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 November 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 5,7-14,22,25-30,43 and 55-63 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 5, 7-14, 22, 25, 26-30, 43 and 55-63 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

*PL*

*RD*

### **DETAILED ACTION**

1. This office action is in reply to an amendment filed on November 17, 2004. Claims 5, 7, 8, 14, 22, 27, 55 and 56 have been amended, claims 1-4, 6, 15-21, 23-24, 31-42, 44-54 and 64-66 have been cancelled. 5, 7-14, 22, 25, 26-30, 43 and 55-63 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed November 17, 2004 have been fully considered but they are not persuasive. Applicant argues that Baena fails to teach/suggest associating with the information representing the audio or audiovisual work the binary key produced, and converting information into a binary key by performing cyclic redundancy check. Furthermore, applicant argues that there is no teachings or suggestion found in either patent (Baena/Kupka) to provide a motivation to make the combination. Examiner respectfully disagrees.

3. Examiner would point out that, in view of the specification the information representing audio or audiovisual work could be software and Baena teaches associating the information representing software work with the binary key produced [column 4, lines 54-57 and column 2, lines 42-46]. Examiner would also point out that the claimed language in claim 5 recites "converting...into a binary key by performing a cyclic redundancy check or other repeatable process on said information." Baena teaches producing a binary key using information derived from at least one physical component of a device capable of rendering the work [column 4, lines 37-57] that inherently implies a repeatable process has to be performed to generate the binary key. Examiner would further point out that In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, with respect to applicants argument that it is not well known to generate a key using physically altered positions, Examiner indicates the following patents US 5,024,495 and US 5,412,718.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 27 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 27 recites the limitation "the alteration". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

7. Claim 54 recites the limitation "the encoding of the binary key...the unique physical media identifier...the optical medium". There is insufficient antecedent basis for these limitations in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 7-14, 22, 25, 26-29, 43 and 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baena-Arnaiz (US Patent No. 6,006,190 (hereinafter referred to as Baena)).

10. As per claim 5, Baena teaches a process for securing information in a digital form comprising:

creating an identifier using information obtained from a device capable of rendering the digitized information to be secured [column 4, lines 37-57];

associating the identifier with the information to be rendered [column 4, lines 54-57 and column 2, lines 42-46];

securing said digitized information by preventing the rendering of the information if the identity of the device upon which the information is to be rendered is not verified using said identifier [column 1, lines 36-42 and column 7, lines 33-35];

wherein the identifier is a binary key suitable for use in an algorithm that can secure said digitized information [column 4, lines, 30-32 and lines 38-40].

Baena teaches obtaining information representing a physical or functional attribute of at least one component in said physical device which is unique to that component [column 4, lines 37-57]; and converting said information into binary key [column 4, line 37-57]. However Baena does not explicitly teach performing a CRC on the information. The claim language recites

performing a cyclic redundancy check or other repeatable process on said information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform CRC or repeatable process on the information in order to convert it to a binary key. To generate the key a repeatable process has to be performed on the attribute of the device [see column 4, lines 37-57]. It would have been obvious because Baena teaches generating 64 bit unique binary key based on functional attribute of component of the device, which is unique to that component [column 4, lines 36-38].

11. As per claims 43 and 63, Baena teaches a process for securely distributing information representing an audio or audiovisual work comprising:

producing a binary key using information derived from at least one physical component of a device capable of rendering the work [column 4, lines 37-57];

distributing the information to the location at which the information is to be rendered [column 6, lines 52-55];

prior to or during the rendering of the information on a device capable of rendering said information, producing a binary key using information derived from at least one physical component of the device [column 7, lines 1-5 and column 4, lines 37-57];

retrieving from said information the binary key associated with said information and comparing the binary key extracted from said information with the binary key produced using information from the device [column 7, lines 33-36];

preventing the rendering of the information if the binary key associated with the information is not identical to the binary key produced using the device [column 7, lines 33-36 and column 8, lines 2-25].

Furthermore, Baena teaches associating the information representing software work with the binary key produced [column 4, lines 54-57 and column 2, lines 42-46]. However Baena does not explicitly teach associating with the information representing the audio or audiovisual work the binary key produced. It would have been obvious to one having ordinary skill in the art at the time the invention was made to associate with the information representing the audio or audiovisual work the binary key produced. It would have been obvious because Baena teaches associating the information representing software work with the binary key produced column 4, lines 54-57 and column 2, lines 42-46].

12. As per claims 7-14, Baena teaches the process, wherein the identifier comprises a binary key of at least 64 bits in length [column 4, lines 27] and generating the key using information unique to the device, and encrypting data using the generated key and preventing rendering of data when the key used for encryption is not associated with the device [column 4, lines 37-57 and column 7, lines 33-35].

13. As per claim 22, Baena teaches the process as applied above. Furthermore, Baena teaches performing memory checksum on the information [see column 5, lines 23-34].

14. As per claim 25, Baena teaches the process as applied above. Furthermore, Baena teaches the process wherein the information is secured by preventing the reading of data from the medium containing the software to be installed [column 2, lines 48-55].

15. As per claims 27-29 and 55-62, Baena teaches the process as applied above. Furthermore, Baena teaches creating an identifier using information obtained from a device capable of rendering the digitized information to be secured [column 4, lines 37-57].

16. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baena-Arnaiz (US Patent No. 6,006,190) in view of Kupka et al. (hereinafter referred to as Kupka) (PCT WO 99/55055)..

17. As per claim 30, Baena teaches a process of installing software across in a manner that prevents the unauthorized duplication or use of the software after it has been installed on a specific computer comprising:

initiating an installation process for installing software onto a computer [column 6, lines 54-58];

producing a unique identifier using information derived from at least one physical component of the computer upon which the software is to be installed [column 4, lines 37-57];

including the unique identifier in at least one file associated with the software to be installed, wherein the absence of said file prevents operation of the software [column 4, lines 54-57 and column 2, lines 42-46];

transferring the files including at least the said file containing the included identifier to the computer upon which the software is to be installed [column 6, lines 52-55];

at the time of execution of the software after it has been installed, producing a unique identifier using information derived from at least one physical component of the computer upon which the software is to be installed [column 7, lines 1-5 and column 4, lines 37-57];

comparing the unique identifier to the unique identifier embedded in the said at least one file associated with the software and if the comparison provides a pre-defined negative result based on the unique identifiers, preventing the software from executing, preventing the operation of the software [column 7, lines 33-36 and column 8, lines 2-25].

Baena does not explicitly teach installing software from a server on to a computer using a network. However, Kupka teaches installing software from a server onto a device using a network [page 4, lines 12-20 and figure 1]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to install software from a server onto a device using a network as per teachings of Kupka into the software installation system taught by Baena in order to have a faster and wider distribution means.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

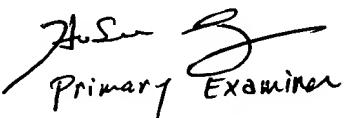
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

May 30, 2005

  
Primary Examiner  
AV 2135